

Docket No. F-6201

Scr. No. 09/308,017

REMARKS

The above amendments and following remarks are responsive to the final Office Action of November 18, 2004 and the Examiner Interview of March 30, 2005. Entry of the Amendments and consideration of the remarks are respectfully requested and a notice of allowance is earnestly solicited.

In the Office Action, claims 44-48, 50-51 and 58 were rejected under 35 U.S.C. §101 because independent claims 44 and 58 fail to recite structural limitations. Applicant has amended claims 44 and 58 to recite the use of one or more computers for accomplishing the tasks recited in the claims.

In the Office Action, claims 44-56 and 58 were rejected under 35 U.S.C. §103 (a) as being unpatentable over Frey (U.S. Pat. No. 5,138,638) as modified by Sizer et al (U.S. Pat. No. 5,923,252). Claim 57 was rejected under 35 U.S.C. §103 (a) as being unpatentable over Sizer as modified by Frey and Fraser (U.S. Pat. No. 5,620,061).

Applicant expresses appreciation to the Examiner Lastra and Supervisory Examiner Myhre for conducting the rejections in the Examiner Interview of March 30, 2005. In the interview, the invention was discussed as illustrated in Figure 1 and disclosed on pages 7 and 8 of the application. Specifically, it was discussed that the application discloses first and second locations. In the first location, there are provided advertisements for products and services located

Docket No. F-6201

Ser. No. 09/308,017

only in the second location, where the advertisements are provided to each customer that enters the first location. Furthermore, the first location and second location are visually and audibly isolated from each other.

After discussing the invention, page 11 of the Office Action was addressed, where the Examiner cites the combination of Frey (U.S. Patent No. 5,138,638) as modified by Sizer (U.S. Patent No. 5,923,252) against Claim 50. In the rejection, the Examiner asserts that Sizer teaches, at column 17, lines 10-15, dividing a detection area into grids to determine the placement of targets (shoppers) and controlling advertisements accordingly. The Examiner has interpreted these recitations to mean that Sizer teaches "said step of presenting the projected messages being conducted in said first range and said step of presenting the purchase being conducted in said second range" as recited in Claim 50.

In response to the rejection, Applicant asserted that the cited text in Sizer teaches only dividing a total area into grids for better controlling of messages displayed in a grid in relation to goods that are located in the same grid. For example, Sizer specifically states at column 17, lines 19-24:

"For example, if a target is positioned quite a way from a product shelf, the message could be something along the lines of "come closer and take a look at this product." When the target comes closer, this will be detected and control delivery of a further message which is appropriate to follow the first message."

Docket No. F-6201

Scr. No. 09/308,017

Accordingly, Sizer teaches that the delivered messages and related products are located in the same grid because otherwise the command "come closer" and the provision of a "further message" after the target moves closer to the shelf would be rendered pointless. As such, Sizer fails to teach that the message and product are visually and audibly isolated from each other.

In response to our discussion of Sizer, the Examiner asserted that it would be obvious to modify Sizer so that product and images are separated. In response to this assertion, Applicant countered that such a modification to Sizer without the aid of a teaching reference is both counter to the teachings of Sizer and impermissible hindsight. *See, W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540 (Fed. Cir. 1983) (a "reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention"); *In re Rouffet*, 149 F.3d 1350 (Fed. Cir. 1998) (requiring the Examiner to provide references that both teach the limitations in the claims and suggest combining their respective teachings "stands as a critical safeguard against hindsight analysis and rote application of the legal test for obviousness").

The Examiner's supervisor agreed that Frey as modified by Sizer fails to teach separating the advertisements from products as discussed and that

Docket No. F-6201

Ser. No. 09/308,017

amending the claims to more clearly recite these limitations would overcome the currently applied rejections.

Based on the discussion with the Examiner's supervisor, Applicant has amended independent claims 44 and 58, starting with "presenting the projected..." to recite:

"providing a second range being visually and audibly isolated from said first range;
projecting messages only in said first range to the total number of potential customers while said potential customers are in said first range, the messages identifying at least one of goods and services purchasable only by entering said second range;
presenting for purchase only in said second range, to at least a portion of the total number of potential customers, the at least one of goods and services identified by messages projected in said first range;
said step of projecting said messages to the potential customers occurring before said step of presenting said goods and services to the potential customers;
determining a total..."

In the amendment to claims 44 and 58, Applicant has further amended the claims to clearly recite that the step of projecting the messages to the customers occurs before the step of presenting the goods and services in the second range. Such a sequence is not required or taught by the prior art. Rather, as indicated, the prior art teaches integrating the presentation of the messages with the presenting of the goods. Accordingly, the prior art teaches away from the amended claims and the claims are patentable over the cited art. *W.L. Gore*, 721 F.2d at 1540.

Docket No. F-6201

Ser. No. 09/308,017

Applicant has further amended Claim 50, first clause, by removing recitations that are presented in amended Claim 44 and canceled Claim 51.

Similar to the above amendments, Applicant has amended independent Claim 52, starting with "a display for presenting..." to recite:

"a second range being visually and audibly isolated from said first range;
a display for presenting a message only in said first range to all of the individuals while said individuals are in said first range, the message identifying at least one of goods and services purchasable only by entering said second range;
said second range exclusively presenting, to at least a portion of all of the individuals, the at least one of goods and services identified by the message presented in said first range;
said display of said messages being visually and audibly provided to all of the individuals before said goods and services are presented to the individuals;
a register..."

Applicant has further amended Claim 53, second clause, by removing recitations that are presented in amended Claim 52.

In the interview, Applicant also discussed the rejection of Claim 53 and commented that the Examiner's interpretation of the placement of the third sensor and the register is incorrect. Specifically, the claim recites that the third sensor and the register are located in the second location. The Examiner asserts that these recitations are taught in Frey, at column 3, lines 63-67, which teaches that the sensor is placed in a "cash office, stockroom, or the like, to monitor traffic in those areas, alerting the management to unusual patterns of activity".

Docket No. F-6201

Ser. No. 09/308,017

In response to the Examiner's assertions, Applicant countered and the Examiner's Supervisor agreed that the claimed placement of the sensor and register in the second region is dissimilar to the placement of a sensor in a cash office or stockroom. Specifically, it was agreed that customers are required to enter the claimed second region to purchase goods or services. On the other hand, customers are, as a rule, prohibited from entering a store's cash office or stockroom.

Furthermore, it was discussed that Sizer teaches, at column 6, line 33-48, discriminating between customers to prevent "false triggering of message delivery." Sizer teaches at column 8, lines 10-15 providing messages "only to people who are perceived to be interested in the products/services being marketed." This contradicts the claimed invention which recites providing the advertisements to all persons that enter the first location. Accordingly Sizer, as a whole, teaches away from the claimed invention and is therefore an improper reference against the claimed invention. *See, W.L. Gore*, 721 F.2d at 1540.

Applicant respectfully requests a two month extension of time for responding to the Office Action. The fee of \$225.00 (small entity) for the extension is provided for in the charge authorization presented in the PTO Form 2038, Credit Card Payment form, provided herewith.

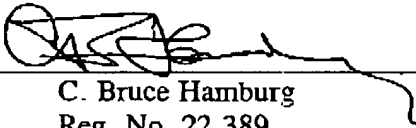
Docket No. F-6201

Ser. No. 09/308,017

If there is any discrepancy between the fee(s) due and the fee payment authorized in the Credit Card Payment Form PTO-2038 or the Form PTO-2038 is missing or fee payment via the Form PTO-2038 cannot be processed, the USPTO is hereby authorized to charge any fee(s) or fee(s) deficiency or credit any excess payment to Deposit Account No. 10-1250.

In light of the foregoing, the application is now believed to be in proper form for allowance of all claims and notice to that effect is earnestly solicited.

Respectfully submitted,
JORDAN AND HAMBURG LLP

By 
C. Bruce Hamburg
Reg. No. 22,389
Attorney for Applicants

Jordan and Hamburg LLP
122 East 42nd Street
New York, New York 10168
(212) 986-2340